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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------------|------------------------------|------------------|
| 10/761,577 | 01/21/2004 | Deborah Lewandowski Barclay | LUC-465/Barclay 10-60-9-9 | 9634 |
| 32205 | 7590 | 07/15/2005 | EXAMINER | |
| PATTI & BRILL ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602 | | | BUI, BING Q | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2642 | |

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/761,577 | Applicant(s) BARCLAY ET AL. | |
| | Examiner Bing Q. Bui | Art Unit 2642 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are pending in the application for examination, wherein claims 1, 10 and 16 being independent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nabkel et al (US Pat No. 5,999,613) in view of Epler et al (US Pat. No. 6,026,156), herein after referred as Nabkel and Epler.

Regarding claim 1, referring to figure 2, Nabkel teaches a call waiting method for use in a telecommunications network in which a first caller is engaged in a current call with a second caller, and for processing an incoming call from a third caller to the first caller, the method comprising the steps of:

- providing identification of a plurality of callers in a predefined caller group (see fig. 2; and col. 2, ln 51-col. 3, ln 48);

- detecting an incoming call from a third caller to a first caller, the first caller presently being engaged in a current call with a second caller (see fig. 2; and col. 2, ln 51-col. 3, ln 48);

- checking if the third caller is a member of the predefined caller group (see fig. 2; and col. 2, ln 51-col. 3, ln 48)

Nabkel fails to teach the steps of:

- signaling the third caller to leave a message to be sent to the first caller with a call waiting indication;
- recording a message from the third caller;
- providing to the first caller a call waiting indication along with the recorder message from the third caller.

However, Epler teaches the above steps that expressed in figure 2, steps 82, 86, 90 and 92. Therefore, integrating Epler's teachings into communication system of Nabkel would have been obvious for enabling the first caller to decide whether or not the on-going call should be interrupted.

Art Unit: 2642

Regarding claims 2-5, 11 and 17, see Nabkel, fig. 2; and col. 2, In 51-col. 3, In 48.

Regarding claims 6-9, 12-15 and 18-20, see Epler, col. 10, In 8-col. 11, In 9.

As to claims 10 and 16, they are rejected for the same reasons set forth to rejecting claim 1 above, since claims 10 and 16 are merely a system for implementing the method defined in the method claim 1.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art in general:

U.S. Pat. No. 5,511,111

U.S. Pat. No. 6,160,877

U.S. Pat. No. 6,343,121

U.S. Pat. No. 6,498,841

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (571) 272-7482. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

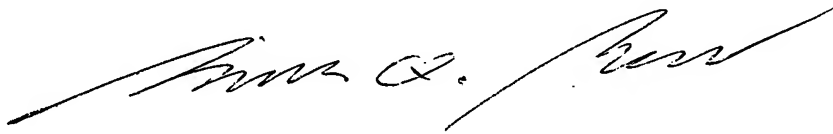
Art Unit: 2642

and for formal communications intended for entry (please label the response

☐EXPEDITED PROCEDURE☐) or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

10 July 2005

A handwritten signature in black ink, appearing to read "Bing Q. Bui", written in a cursive style.

BING Q. BUI
PRIMARY EXAMINER